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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/296,207 04/21/99 ARUNACHALAM

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JM02/0629
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EXAMINER

VLLV

ART UNIT

PAPER NUMBER

2758

DATE MAILED:

06/29/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/296,207

Applicant(s)

Arunachalam

Examiner

V. Vw

Group Art Unit

2758

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE —3— MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 12-7-99 (IDS)
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-54 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-11, 34, 41-54 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 12-33, 35-40 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

DETAILED ACTION

Restriction:

1. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-11, 34 and 41-54, drawn to remote access, classified in Class 709, subclasses 202, 217 and 225.

II. Claims 12-33 and 35-40, drawn to data structure of a directory service, classified in Class 707, subclasses 10, 100 and 104.

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as enabling a remote access to an application server. On the other hand, invention II has separate utility such as providing directory services and data routing in the network. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separated status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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2. During a telephone conversation with Mr. Salter on June 21, 2000 a provisional election was made with traverse to prosecute the invention of I, claims 1-11, 34 and 41-54. Affirmation of this election must be made by applicant in replying to this Office action.

Claims 12-33 and 35-40 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Non-Art Rejection:

3. The following non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. In re Sarett, 327 F2.d 1005, 140 USPQ 474 (CCPA 1964); In re Schneller, 397 F2.d 350, 158 USPQ 210 (CCPA 1968); In re White, 405 F2.d 904, 160 USPQ 644 (CCPA 1969); In re Thorington, 418 F2.d 528, 163 USPQ 644 (CCPA 1969); In re Vogel, 422 F2.d 438, 164 USPQ 619 (CCPA 1970); In re Van Ornam, 686 F2.d 937, 214 USPQ 761 (CCPA 1970); In re Longi, 759 F2.d 887, 225 USPQ 645 (Fed. Cir. 1985); and In re Goodman, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection

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on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

4. Claims 1-11, 34 and 41-54 are rejected under the judicially created doctrine of double patenting as being unpatentable over prior U.S. Patent No. 5,987,500.

The subject matter recited in claims 1-11, 34 and 41-54 of the patent application is fully disclosed in the patent. The allowance of these claims would extend the rights to exclude already granted in claims 1-35 of the patent. Furthermore, there is no apparent reason why applicant was prevented from presenting the claims in the application for examination during the prosecution of the issued patent.

Art Rejection:

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 1-11, 34 and 41-54 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Focsaneanu et al, hereafter Focsaneanu, U.S. pat. No. 5,828,666.

Focsaneanu discloses a network switch for enabling remote access to a value-added application comprising:

a) means for switching to a transactional application comprising:

i) means for receiving user specification (col 7, lines 61-67),

ii) means for enabling the switch, activating the transactional application and creating a transaction link (col 8, lines 6-14),

b) means for transmitting a transaction request from the transactional application (col 8, lines 15-21),

c) means for processing the transaction request including sending the request to a host and receiving data from the host (see col 10, lines 57-64 and col 2, lines 57-61).

As to claims 41-54, Focsaneanu's network switch performs packet packaging, automated state management and transactions in real time to connect clients to a plurality of backend network services including usage-based services (see col 8, lines 6-39).

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Conclusion:

7. The references cited by the examiner on PTO-892 but not relied upon are considered pertinent to applicant's disclosure.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Viet Vu whose telephone number is (703) 305-9597. The examiner can normally be reached on Monday through Friday from 7:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on (703) 305-4731.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.



**VIET D. VU
PRIMARY EXAMINER**

Art Unit 2758
6/22/00